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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,306	06/23/2000	Brian Wolfe	5053-36200	1775

7590 11/28/2003

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EXAMINER	
PASS, NATALIE	
ART UNIT	**PAPER NUMBER**
3626	11

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/603,306	WOLFE, BRIAN	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *none*.

   Claim(s) objected to: *none*.

   Claim(s) rejected: *1-9,11-25,27-39,41-51 and 53-56*.

   Claim(s) withdrawn from consideration: *none*.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

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Continuation of 5. does NOT place the application in condition for allowance because:

i. Applicant apparently rehashes arguments previously addressed in the Final Office Action (paper number 9). In particular, each and every limitation of independent claims 1, 17, 31, and 47 and dependent claims 2-16, 18-30, 32-46, and 48-56, including dependent claims 10, 26, 40 and 52, were properly addressed in pages 2-5 of the detailed Final Office Action and pages 2-15 of the detailed Non-Final Office Action, and are incorporated herein. In addition, the motivation to combine the applied references, was clearly accompanied by select portions of the respective references which specifically support that particular motivation [see paper number 6, pages 2-15].

ii. Applicant points out that claims 1, 17, 31 and 47 include the limitation of "wherein the insurance claim comprises a bodily injury claim...[...] ...general damages value" and that the combination of the Huffman, Kuwamoto Ertel, Winans, McGauley and Abbruzzese references does not teach these limitations. In response, the Examiner strongly advises that the claimed invention was considered "as a whole" and that every limitation recited in the claims were specially addressed within the prior Office Actions (papers number 6 and 9) and further that Applicant fails to appreciate the breadth of the claim language that is presently recited.

iii. Applicant analyzes the applied references separately in the Response After Final Office Action, and argues each of the references individually, and therefore fails to consider the full teachings of the applied references. In response to Applicant's piecemeal analysis of the references, it has been held, as noted in the Final Office Action, that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, according to In re Jacoby, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In re Jacoby, 135 USPQ 317 (CCPA 1962).

iv. Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions, if any, are there between Applicant's recited "wherein the insurance claim comprises a bodily injury claim...[...] ...general damages value" and the corresponding elements of the Huffman, Kuwamoto Ertel, Winans, McGauley and Abbruzzese references? Also, arguments or conclusions of Attorney cannot take the place of evidence. In re Cole, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); In re Schulze, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); Mertizner v. Mindick, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

v. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Continuation of 7. An explanation of how the amended claims would be rejected:

Huffman and Kuwamoto teach a method and system and carrier medium as analyzed and disclosed in claims 1, 17, 31 and 47 but fail to explicitly disclose wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value. However, Abbruzzese teaches wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value (Abbruzzese; column 24, line 52 to column 25, line 12, Tables XII and XVI (columns 27-28 and 31 respectively), column 43, lines 45-49, column 138, lines 55-58). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system and carrier medium of Huffman and Kuwamoto to include wherein the insurance claim comprises a bodily injury claim, and wherein said processing the insurance claim comprises processing the bodily injury claim to estimate a bodily injury general damages value, as taught by Abbruzzese, with the motivation of minimizing the time to prepare and complete all insurance forms, letters, reports and checks in processing insurance claims, reducing or eliminating paper in the maintenance of records in processing work, electronically capturing all physical documentation for the processing of claims, enabling them to be readily stored and retrieved, electronically associating substantiating documentation with all payment transactions undertaken through a computerized work management system enabling them to be readily stored and retrieved (Abbruzzese; column 2, lines 35-46).